

REMARKS/ARGUMENTS

The Office Action of August 23, 2005, has been reviewed, and in view of the following remarks, reconsideration and allowance of all of the claims pending in the application are respectfully requested. Claims 7, 11-35, 42 and 46-66 are canceled. Claims 1-6, 8-10, 36-41 and 43-45 remain pending. No new matter has been added.

Claim Objections

Claims 1 and 36 are currently objected to because “digital images” is not found in the original specification. The Office Action alleges that the closest comparable reference is “digitally imaging” and “capturing digital check image.” Applicants respectfully disagree. The term “digital images” is used throughout the specification. *See e.g.*, Abstract, paragraphs [0037] and [0040] and the original claims (*e.g.*, claims 42-47).

Claim Rejections under 35 U.S.C. § 112

Claims 1-6 and 7-10 are currently rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Specifically, the Office Action alleges that the term “discarding” is not explained in the specification.

The claim limitation states “discarding the second item sequence numbers *such that the second records are indexable according to the first item sequence number.*” (emphasis added). Applicants believe that this statement is clear and complies with the written description requirement. For clarification, the term “discarding” may include “removing” or “getting rid of,” according to Merriam-Webster Online Dictionary. Applicants submit that the limitation complies with the written description requirement and respectfully request further clarification of the rejection.

Claim Rejections under 35 U.S.C. § 103(a)

Claims 1-10 and 36-45 are currently rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Patent No. 5,930,778 to Geer ("Geer") in view of U.S. Patent No. 5,532,464 to Josephson ("Josephson"), U.S. Patent No. 5,678,046 to Cahill *et al* ("Cahill") and U.S. Patent No. 5,502,576 to Ramsay *et al* ("Ramsay").

Geer purports to disclose a system for expediting the clearing of financial instruments and coordinating the same with invoice processing at the point of receipt. In connection with example I, Geer specifically states that paper checks are not transported (column 6, lines 40-41). Information is extracted from the checks and converted into electronic form (column 6, lines 41-45). The physical checks are disposed of following the imaging and archival storage so that checks are truncated at the point of receipt (column 6, lines 41-49). As shown in Figure 1, papers checks are imaged at 7 and subsequently archived and destroyed at 9. The electronic information is scanned at 6. Geer fails to show a correlation between the electronic image at 7 and the scanned information at 6.

The Office Action admits the major deficiencies of Geer. More specifically, Geer fails to show at least the steps of "*correlating the first and second records.*" and "*discarding the second item sequence numbers such that the second records are indexable according to the first item sequence number wherein the second records and the digital images are linked to the first records by the first item sequence number.*"

In addition, Geer further fails to show "receiving the paper-based banking transactions after having received the ECP file."¹ The excerpt relied upon by the Office Action fails to show

¹ Office Action mailed February 4, 2005 admits that Geer does not disclose this limitation, see page 3.

that paper-based banking transactions are received *after* the ECP file. This limitation is clearly lacking in Geer. Further, none of the applied references disclose this missing feature.

The Office Action relies upon Josephson, Cahill and Ramsay for the admitted major deficiencies of Geer. Josephson correlates item sequence numbers assigned by other banks with different item sequence numbers (column 3, line 32 to column 5, line 9). Therefore, the checks are reconciled across different banks. The correlation across different banking schemes of Josephson is fundamentally different from the claimed correlation step of first records and second records. The Office Action has failed to address this major difference.

The Office Action turns to Cahill to teach “discarding the second item sequence numbers such that the second records are indexable according to the first item sequence number.” As shown in Figure 3 and 5, Cahill shows a storage device 202 at sort station 2 with a temporary storage of check images and associated data before the image is provided on network 3. After index records 28 are written, TIFF files 22 are deleted from storage space 505. Cahill does not assign a unique second item sequence number to second records, correlate the first and second records and further discard the second item sequence numbers such that records are indexable according to the first record number. The Office Action alleges that Cahill discloses that the TIFF files are deleted, but there is no mention of assigning a second item sequence number or discarding the second item sequence number. The Office Action has failed to show how deleting TIFF files in Cahill is equivalent to the claimed steps of “*for each of the second records, assigning a unique second item sequence number to each respective second record;*” “*correlating the first and second records;*” and “*discarding the second item sequence numbers such that the second records are indexable according to the first item sequence number wherein*

the second records and the digital images are linked to the first records by the first item sequence number.”

Finally, the Office Action relies upon a fourth reference, Ramsay, to address the major deficiencies of Geer, Josephson and Cahill. Ramsay is directed to the transmission, storage and retrieval of documents in an electronic domain. Ramsay is not related to electronic check presentment or processing. Rather, Ramsay is directed to storage and retrieval of a two-dimensional electronic image expressible as a digital array or bitmap for the purpose of interactive document processing (abstract, col. 42, lines 59-64).

Based on these disclosures, the Office Action summarily concludes that it would have been obvious to combine the disclosures of Geer and Ramsay “to capture the image of an item and assign a sequence number to the image,” without providing a basis for combining the disclosures. In addition, the Office Action concludes that it would have been obvious to combine Geer and Ramsay with Josephson “to relate the image sequence number to serial number of the time (cross reference),” without providing any statement of motivation for making the suggested modification. Further, the Office Action concludes that it would have been obvious to combine Geer and Ramsay with Josephson with Cahill “for improved database managing of document retrieval using indexed record.” *See* page 5, Office Action mailed August 23, 2005. The Office Action has failed to provide a proper statement of motivation for combining four disparate references. Instead, the alleged statements of motivation are based on improper hindsight.

The Office Action has failed to set forth a *prima facie* case of obviousness for the independent claims. Specifically, when a primary reference is missing elements, the law of obviousness requires that the Office set forth some motivation why one of ordinary skill in the

art would have been motivated to modify the primary reference in the exact manner proposed. *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 664 (Fed. Cir. 2000). In other words, there must be some recognition that the primary reference has a problem and that the proposed modification will solve that exact problem. All of this motivation must come from the teachings of the prior art to avoid impermissible hindsight looking back at the time of the invention.

In the present case, the Office Action's justification for combining Geer, Josephson, Cahill, and Ramsay has absolutely nothing to do with the deficiencies of Geer. As admitted by the Office Action, Geer fails to show at least the steps of "correlating the first and second records" and "discarding the second item sequence numbers such that the second records are indexable according to the first item sequence number." To properly modify Geer to correct for these major deficiencies, the Office Action has the burden to show some motivation why providing those elements would have overcome some perceived problem with Geer. Any such motivation is completely lacking.

Accordingly, the Office Action has failed to provide any proper motivation for modifying Geer as taught by Josephson, Cahill and Ramsay, so the proposed modification fails. In fact, Geer, Josephson, Cahill and Ramsay are improperly combined and lack proper motivation. Even if the combination of Geer, Josephson, Cahill and Ramsay could be modified as suggested by the Office Action, the resulting combination would nevertheless fail to show each and every limitation claimed by Applicants.

The mere fact that Geer, Josephson, Cahill and Ramsay can be somehow combined and modified does not render the resultant modification obvious unless there is a suggestion or motivation found somewhere in the prior art regarding the desirability of the combination or modification. *See* M.P.E.P § 2143.01; *see also In re Mills*, 16 U.S.P.Q.2d 1430, 1432 (Fed. Cir.

1990); *In re Fritz*, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). In addition, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Furthermore, the fact that four disparate references are needed in combination to address Applicants' claimed invention further supports a finding of non-obviousness. The suggestion to combine becomes less plausible when the necessary elements can only be found in a large number of references. Donald S. Chisum, *Chisum on Patents* §5.04[I][e][6] (2002).

As the remaining dependent claims 2-6, 8-10, 37-41 and 43-45 encompass the limitations of independent claims 1 and 36, these claims should be allowed for at least the reasons stated above.

CONCLUSION

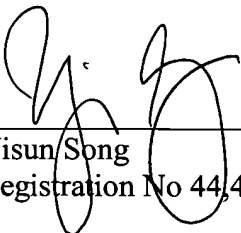
In view of the foregoing amendments and arguments, it is respectfully submitted that this application is now in condition for allowance. If the Examiner believes that prosecution and allowance of the application will be expedited through an interview, whether personal or telephonic, the Examiner is invited to telephone the undersigned with any suggestions leading to the favorable disposition of the application.

It is believed that no fees are due for filing this Response. However, the Director is hereby authorized to treat any current or future reply, requiring a petition for an extension of time for its timely submission as incorporating a petition for extension of time for the appropriate length of time. Applicants also authorize the Director to charge all required fees, fees under 37 C.F.R. §1.17, or all required extension of time fees, to the undersigned's Deposit Account No. 50-0206.

Respectfully submitted,

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